



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,289	06/13/2000	Paul E. Bender	PA000322	7796

23696 7590 06/25/2004

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

NGUYEN, STEVEN H D

ART UNIT	PAPER NUMBER
----------	--------------

2665

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,289

Applicant(s)

BENDER ET AL.

Examiner

Steven HD Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8, 12 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457).

Regarding claim 1-8, 12 and 14-20, Holmes discloses (Figs 1-4 and col. 1, lines 5 to col. 4, lines 12) a method for receiving messages forwarded from a second radio network (Fig 2, Ref 201) to a first radio network (Fig 2, Ref 252) by establishing a session with the first radio network (Fig 4, Ref 402); sending to the first radio network an first message for indication of an interest in receiving unsolicited messages for a particular set of service options from the second radio network (Fig 4, Ref 403, the mobile notifies the second network must transmit a page message via PCCH of the first network to the mobile) and registering with the second network before receiving a page message (Fig 4, Ref 401) and the unsolicited messages are sent from the second radio network to the first radio network. (Fig 2); the encapsulated message is received from the first radio network on a designated control channel cycle (Fig 2, Ref PCCH). However, Holmes does not disclose the page message must be encapsulating in order to transmit via the PCCH. In the same field of endeavor, Silver discloses (Figs 1-6 and col. 1, lines 17 to col. 9, lines 67) receiving an encapsulated message from the first radio network, wherein the encapsulated message includes an unsolicited message from the second radio network that has

Art Unit: 2665

been forwarded to the first radio network (Figs 3-4 wherein the mobile receives an encapsulating from the first network via PCCH wherein the encapsulated includes a received unsolicited message "page message" from the second network; See col. 6, lines 1-48) and the first message is sent periodically within a first time interval and the encapsulating and forwarding of the unsolicited messages from the second radio network cease if the first message is not received within a second time interval, wherein the second time interval is longer than the first time interval and sending a second message to the first radio network to request termination of the encapsulating and forwarding of the unsolicited messages from the second radio network. (Col. 7, lines 12-30, the mobile periodically notifies its present to receive the messages and the first network will not forward the message if it does not receive the notified message and it is implicitly discloses if the mobile does not want to receive the message via PCCH, its will send a disconnection message to the first network) and sending a page response message to the second radio network in response to receiving the encapsulated message from the first radio network (Figs 3-4 and Page RESP on DCCH); the encapsulated message received from the first radio network is a paging request message; a voice page; the first radio network is a High Data Rate radio network; the second radio network is a CDMA radio network that conforms to 1S-2000 standard. (Col. 4, lines 40-62 and col. 6, lines 1-31 and Fig 2, HDR is data network 120 and CDMA-2000 is voice network 110).

Since, Homes suggests that MDIS creating a IP packet for transmitting via PCCH to the mobile for alerting an incoming call. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for encapsulating a received page message from the second network at the first network for

transmitting to the mobile station as disclosed by Silver into Holmes' system and method. The motivation would have been to reduce a delay for setting up a telephone call.

3. Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes and Silver as applied to claims 1 above, and further in view of Stephens (USP 6600920).

Regarding claims 9 and 11, Holmes and Silver do not fully disclose the claimed invention. However, Stephens discloses establishing a connection with the second radio network in response to receiving the encapsulated message and the unsolicited messages are sent from a mobile station controller to the first and second radio networks (Figs 7-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to establish a communication channel between the second network and mobile as disclosed by Stephens' system into the system of Holmes and Silver. The motivation would have been to reduce a delay for setting up a telephone call.

Regarding claims 10 and 13, Holmes does not fully disclose the claimed invention. Silver discloses an encapsulating message. However, it is well known and expected in the art for an encapsulated message includes an Access Terminal Identifier (ATI) Record field indicative of an address of a recipient access terminal, a Message ID field that indicates that the message is an encapsulated message, and a message field indicative of one or more paging records for the recipient access terminal for forwarding via forward channel. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply these field into an encapsulated message of Silver for forwarding via traffic channel instead of packet control channel is a designer choice. The motivation would have been to reduce a delay for setting up a telephone call.

4. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457) and Chevillat (USP 6181683).

Holmes and Silver discloses the claimed invention as set forth of the claims 1, 4-7 and 20 of paragraph 6 of the office action. However, Holmes and Silver does not fully disclose a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller. In the same field of endeavor, Chevillat disclose (Fig 2 and 5) disclose a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller as disclosed by Chevillat's system into the system of Holmes and Silver. The motivation would have been to reduce a delay for setting up a telephone call.

Response to Arguments

5. Applicant's arguments filed 5/6/04 have been fully considered but they are not persuasive.

In response to pages 11-13, the applicant states that Holmes and Silver fail to disclose the claimed invention such as receiving an encapsulated message, which includes a unsolicited message that has been forwarded from the second network, from the first network. In reply, Holmes discloses a method and system for allowing the terminal to receive a message from the second network via the first network when the terminal is located in an overlapping region. The first network receives a page message "unsolicited message" from the second network and translating the page message of the second network (PSTN) into a page message of the first network (Packet network) for transmitting to the terminal. Silver discloses a method and system for delivering a page message "unsolicited message" from the second network "TDMA, CDMA" to a terminal camped on the first network "packet network" by encapsulating the page message by using IP address for establishing IP tunnel (See col. 6, lines 29-31 and Figs 3-4, IP tunnel).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Holmes discloses a method and system for allowing the terminal to receive a message from the second network via the first network when the terminal is located in an overlapping region. The first network receives a page message "unsolicited message" from the second network and translating the page message of the second network (PSTN) into a page message of the first network (Packet network) for transmitting to the terminal. Silver discloses a

method and system for delivering a page message “unsolicited message” from the second network “TDMA, CDMA” to a terminal camped on the first network “packet network” by encapsulating the page message by using IP address for establishing IP tunnel (See col. 6, lines 29-31 and Figs 3-4, IP tunnel). Since, Homes suggests that an IP packet is generated from a page message from the second network for transmitting via PCCH of the first network to the mobile for alerting an incoming call and Silver suggests that encapsulating method is well known and expected in the packet network.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

Art Unit: 2665

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven HD Nguyen
Primary Examiner
Art Unit 2665
6/14/04